

REMARKS

Claims 1-20 were pending in this application.

Claims 1-20 have been rejected.

Claims 1, 5-7, 11-13, 18, and 20 have been amended as shown above.

Claim 17 has been cancelled.

Claim 21 has been added.

Claims 1-16 and 18-21 are now pending in this application.

Reconsideration and full allowance of Claims 1-16 and 18-21 are respectfully requested.

I. REJECTION UNDER 35 U.S.C. § 103

The Office Action rejects Claims 1-16 and 18-20 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,288,561 to Leedy (“Leedy”) in view of U.S. Patent No. 6,501,290 to Kvanvig et al. (“Kvanvig”). This rejection is respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. (*MPEP* § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992)). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. (*MPEP* § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984)). Only when a *prima facie* case of obviousness is established does the burden shift to the Applicant to produce evidence of nonobviousness. (*MPEP* § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d

1443, 1444 (*Fed. Cir. 1992*); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (*Fed. Cir. 1993*)). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the Applicant is entitled to grant of a patent. (*In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (*Fed. Cir. 1992*); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (*Fed. Cir. 1985*)).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. (*In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (*Fed. Cir. 1993*)). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on the Applicant's disclosure. (*MPEP* § 2142).

Claims 1, 7, and 13 have been amended to recite that a "printed circuit board" (which receives or is operable to receive a "device under test") includes a "leadless socket." *Leedy* and *Kvanvig* both fail to disclose, teach, or suggest these elements of Claims 1, 7, and 13.

Leedy recites a system that performs various functions related to integrated circuits, including testing the integrated circuits and reducing the oxide thickness of the integrated circuits. (*Abstract*). The system includes a chamber 10 having various modules 14a-14e for

processing semiconductor wafers. (*Col. 3, Lines 50-55*). The module 14a includes a probing device 42 having probe points 44 for contacting and probing a wafer 40. (*Col. 4, Lines 45-48*). A thermal control device 48 contacts the wafer 40 and controls the temperature of the wafer 40. (*Col. 4, Lines 48-52*). A gas source 50 provides non-oxidizing gases into the module 14a. (*Col. 4, Lines 52-53*).

Leedy simply recites that a wafer 40 is contacted by a probing device 42 having probe points 44 and by a thermal control device 48. *Leedy* lacks any mention that the probing device 42 or the thermal control device 48 represents or includes a “printed circuit board comprising a leadless socket.” As a result, *Leedy* fails to disclose, teach, or suggest a “printed circuit board” (which receives or is operable to receive a “device under test”) that includes a “leadless socket” as recited in Claims 1, 7, and 13.

Kvanvig recites a system for testing a device. (*Abstract*). The device being tested is placed on a chuck 220. (*Col. 2, Lines 47-53*). A thermal conditioning unit 230 supplies coolant to the chuck 220, which controls the temperature of the device being tested. (*Col. 2, Lines 53-58*). A positioning apparatus 240 moves the chuck 220 so the device being tested contacts a test apparatus 250, which then tests the device. (*Col. 3, Lines 1-10*).

Kvanvig simply recites that a chuck 220 receives a device and a test apparatus 250 contacts and tests the device. *Kvanvig* lacks any mention that the chuck 220 or the test apparatus 250 represents or includes a “printed circuit board comprising a leadless socket.” As a result, *Kvanvig* fails to disclose, teach, or suggest a “printed circuit board” (which receives or is operable to receive a “device under test”) that includes a “leadless socket” as recited in Claims 1,

7, and 13.

In addition, Claims 5, 11, and 17 previously recited that the “printed circuit board comprises a leadless socket.” The Office Action makes no attempt to show that *Leedy* or *Kvanvig* discloses, teaches, or suggests these elements. Rather, the Office Action states that Claim 11 (among others) recites an “obvious” method of “using the apparatus of the above-combination.” (*Office Action, Page 3, Fourth paragraph*). The Office Action also states that Claim 17 (among others) is “within the operable scope of the above combination.” (*Office Action, Page 3, Fifth paragraph*). Claim 5 is never discussed in the Office Action. None of this explains exactly how the proposed *Leedy-Kvanvig* combination discloses, teaches, or suggests the elements previously recited in Claims 5, 11, and 17 (now recited in Claims 1, 7, and 13).

For these reasons, the Office Action has not established a *prima facie* case of obviousness against Claims 1, 7, and 13 (and their dependent claims). Accordingly, the Applicant respectfully requests withdrawal of the § 103 rejection and full allowance of Claims 1-16 and 18-20.

II. NEW CLAIM

The Applicant has added new Claim 21. The Applicant respectfully submits that no new matter has been added. At a minimum, the Applicant respectfully submits that Claim 21 is patentable for the reasons discussed above. The Applicant respectfully requests entry and full allowance of Claim 21.

III. CONCLUSION

The Applicant respectfully asserts that all pending claims in this application are in condition for allowance and respectfully requests full allowance of the claims.

SUMMARY


If any outstanding issues remain, or if the Examiner has any further suggestions for expediting prosecution of this application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

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